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PATENT
Attorney Docket No.: AVALUC-01701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Group Art Unit: 2143
	Examiner: Dennison, Jerry
Louis Bouchard *et al.*	
	TRANSMITTAL LETTER
Serial No.: 09/697,113	
	162 North Wolfe Road
Filed: 10/25/00	Sunnyvale, California 94086
	(408) 530-9700
For: **INSTANT MESSAGE NOTIFICATION APPLICATION**	Customer Number 28960

MS: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed please find a reply brief in response to examiner's anwer for filing with the U.S. Patent and Trademark Office.

The Commissioner is authorized to charge any additional fee or credit any overpayment to our Deposit Account No. 08-1275. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: June 8, 2005

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CERTIFICATE OF MAILING (37 CFR§ 1.8(a))
I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.
Date: 6-8-05 By: Jun D. Ramos

PATENT
Atty. Docket No.: AVALUC-01701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	Group Art Unit: 2143
Louis Bouchard	Examiner: Dennison, Jerry
Serial No.: 09/697,113	
Filed: October 25, 2000	**REPLY BRIEF IN RESPONSE TO EXAMINER'S ANSWER**
For: **INSTANT MESSAGE NOTIFICATION APPLICATION**	
	162 N. Wolfe Rd. Sunnyvale, CA 94086 (408) 530-9700
	Customer No. 28960

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed on April 8, 2005, this Reply Brief is hereby submitted. Claims 1, 3-20, and 22-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,535,586 issued to Cloutier et al. (hereafter "Cloutier") in view of U.S. Patent No. 6,449,344 issued to Goldfinger et al. (hereafter "Goldfinger"). The appellant submits this brief to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.41, as stated in *Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule)*, 69 Fed. Reg. 49959 (August 12, 2004).

The appellant contends that the rejection of Claims 1, 3-20, and 22-27 in this pending application is in error and should be overcome by this appeal. The appellant further contends that the Cloutier and Goldfinger references, used as a basis of the rejections of the pending claims, have been misapplied in order to attempt to support the rejection of Claims 1, 3-20, and 22-27.

I. SUMMARY OF THE CLAIMED INVENTION

The claimed invention is directed to an apparatus for and a method of providing message notification for a user through an instant messaging service. A message notification application 10 is registered to an instant messaging service 14 through an IP Network 16 such as the Internet or a private intranet (Present Specification, page 3, lines 26-28). The message notification application 10 maintains a buddy list corresponding to the instant messaging service 14 (Present Specification, page 4, line 20). In the case of multiple internet messaging services, a separate buddy list for each instant messaging service is maintained by the message notification application 10 (Present Specification, page 4, lines 24-27). When a number of users utilizing various instant messaging services 14 are signed up for the message notification application 10, the message notification application 10 can be registered with multiple instant messaging services 14 to enable it to communicate with users regardless of the instant messaging service 14 being utilized (Present Specification, page 3, line 33 to page 4, line 3). When the user logs onto the instant messaging service 14 using a particular internet appliance 18, the user instructs the message notification application 10 that the user desires to be notified when a new mail message is received by a message server (Present Specification, page 4, lines 18-20). The message notification application 10 then adds the user to the buddy list corresponding to the instant messaging service 14 currently used by the user (Present Specification, page 4, line 20).

The message notification application 10 operates on, or is coupled to, one of an application, voice messaging or unified server 12, hereinafter referred to as message server 12 (Present Specification, page 4, lines 4-5). When a new mail message is received by the message server 12, the message notification application 10 sends an instant message notification via the instant messaging service 14 for delivery to the user (Present Specification, page 3, lines 11-13 and page 4, lines 28-29). The instant messaging service 14 transmits the instant message notification to the internet appliance 18 currently used to access the instant messaging service 14 by the user (Present Specification, page 5, lines 12-16). The message notification application 10 does not directly transmit the instant message notification to the end user; instead, the message notification application 10 determines the proper instant messaging service 14 according to the buddy list currently listing the end user and then sends a message notification to the determined instant messaging service 14. In turn, the instant messaging service 14 sends an instant message notification to the user. In this manner, the message notification application 10 functions as an interface between the message server 12 and the instant messaging service 14. As an interface, the message notification application 10 functions in a transparent manner such that the instant messaging service 14 perceives the message server 12 as another end user.

Within the present specification, a clear distinction is made between "instant message notifications" and "messages" (also referred to as "mail messages"). "Messages" are those data that are addressed to a particular end user and are stored on the message server 12. Examples of such "message" types include email messages, voice mail messages, and fax mail messages (Present Specification, page 5, lines 8-11). Users can be notified of received "messages" using different types of conventional "message notification systems", such as a "message waiting" indication light on a phone, "stutter" dial tone on a home phone, an icon or short message on a wireless handset's display, a numeric message to a pager and numerous others (Present Specification, page 2, lines 20-25). In contrast, "instant message notifications" are those data that are addressed to a particular end user and are instantly communicated to the particular user via a pop up box on the user's screen (Present Specification, page 1, lines 22-26). "Instant message notifications" are utilized within an Instant Messaging Service, which are well known in the art. Examples of specific Instant Messaging Services include AOL Instant Messenger®, MSN Messenger®, Yahoo! Messenger®, ICQ® or any privately-provided instant messaging service (Present Specification, page3, lines 30-33). It is well known in the art that "messages" and "message notification systems" are different than "instant messaging notifications" and "instant messaging services".

II. SUMMARY OF TEACHINGS OF CLOUTIER

Cloutier teaches a system to provide messaging services to alert a message service subscriber to the receipt of a high priority message and to provide the remote retrieval thereof. An email server 110 stores email messages received over the internet 130 (Cloutier, col. 1, lines 26-27). The messaging system server 120 periodically polls the email server 110 for new messages, and if a new message is received, then a unique message code corresponding to the new message is generated by the messaging system server 120 (Cloutier, col. 4, line 63 to col. 5, line 4). The unique message code is sent from the messaging system server 120 to a wireless device 170 used by the subscriber (Cloutier, col. 5, lines 17-22). To retrieve the new message, the subscriber uses a different device then the wireless device 170. In particular, the subscriber accesses the messaging system server 120 using an access device 190 connected via a user interface 140 (Cloutier, col. 4, lines 26-38).

III. SUMMARY OF TEACHINGS OF GOLDFINGER

Goldfinger teaches a communications system for locating a user who is connected to a communications network. A first user 18 accesses a communications network 14 via a terminal

12 (Goldfinger, col. 5, lines 24-27). Once user 18 is connected to the network 14, a connection notification apparatus 30 notifies a connection monitor 22 that user 18 is connected to network 14 (Goldfinger, col. 5, lines 37-40). The connection notification apparatus 30 is included in the terminal 12, and the connection monitor 22 is part of a server 20, the server 20 also connected to the network 14 (Goldfinger, Figure 1). An information apparatus manager 28 is also included within the server 20 and maintains a list of all users currently connected to the network 14 (Goldfinger, col. 5, line 61 to col. 6, line 2). The user 18 defines a list of sought users which the user 18 is interested in communicating with, and provides this list to the information apparatus manager 28 (Goldfinger, col. 6, lines 3-5). The information apparatus manager 28 uses this list on an on-going basis to determine if any of the sought users are currently connected to the network 14 (Goldfinger, col. 6, lines 13-18). If a sought user is connected, the information apparatus manager 28 causes an annunciator 24 within the server 20 to transmit an annunciation to user 18 (Goldfinger, col. 6, lines 19-24). The annunciation is then sent to the user 18 (Goldfinger, col. 6, lines 42-48). In other words, the server 20, which includes the information apparatus manager 28 and the annunciator 24, maintains the list of sought users and generates an annunciation and sends the annunciation to the user whenever a sought user from the list access the network 14. The server 20 does not send message notifications.

IV. MISAPPLICATION OF THE CLOUTIER AND GOLDFINGER REFERENCES AND RESPONSE TO EXAMINER'S ANSWER

The appellant contends that Claims 1, 3-20, and 22-27 are patentable over Cloutier in view of Goldfinger for at least the following reasons:

1. There is not a proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Within the Examiner's Answer, it is stated that "Cloutier suggests what Goldfinger provides" and that "a network administrator would have motivation to incorporate the teachings of Goldfinger into the notification system of Cloutier, providing another type of notification, to notify clients that a message has been received." More specifically, it is stated within the Examiner's Answer that Cloutier suggests that different methods of notification are possible, and that this suggestion is the motivation to combine with the communication network of Goldfinger. To support this position, the Abstract of Cloutier is cited, which states that "[t]he unique code is transmitted in a message alert, which may be implemented for a variety of media," and column 3, lines 39-41 of Cloutier is cited, which states that "[t]he notification and remote retrieval process aspects of the present invention are designed

to work in conjunction with one another but also may be used independently and may be combined with other messaging system architectures." The appellant respectfully disagrees with the conclusions reached as to these cited passages.

First, the cited phrase, "...message alert, which may be implemented for a variety of media" refers to a variety of messaging media, for example email, voice mail, or fax. The phrase "implemented for" refers to the type of media, e.g. email, voice mail, or fax, for which the message alert is implemented. The cited passage does not state that the message alert is "transmitted over" a variety of media, which would apply to the method and network for delivering the message alert. This conclusion is further substantiated in the Abstract, which states "[t]he present invention is highly flexible and can be designed to work with any type of electronic message including email, voice mail, facsimile, etc." The cited passage does not refer to various types of networks that can be used to provide a notification message, where a notification message is clearly different than an electronic message.

Second, the cited phrase, "...may be combined with other messaging system architectures" must be taken into context with the remaining portion of the sentence, which states "[t]he notification and remote retrieval process aspects of the present invention ... may be combined with other messaging system architectures." Cloutier does not explicitly teach what "notification and retrieval aspects" are being referred to. For example, a first notification and retrieval aspect can refer to the interaction between the email server 110 and the messaging system server 120 to determine when a new message arrives on email server 110, to generate a message code , and to generate a notification message by the messaging system server 120. Or, a second notification and retrieval aspect can refer to the interaction between the messaging system server 120 and the end user device 170, 190 to send the notification message to the end user device 170, 190 and to contact the messaging system server 120 by the end user device 170, 190 to retrieve the message corresponding to the message code contained within the notification message. However, it can be implied that "notification and retrieval aspects" refers to the first notification and retrieval aspect. This follows since Cloutier explicitly states that the notification and retrieval aspects "may be combined with other messaging system architectures", and Cloutier previously defines "messaging systems" as those systems that provide messaging services such as email, voice mail, and fax (Cloutier, col. 1, lines 15-19, and col. 1, lines 30-36).

Therefore, Cloutier suggests that it's notification and retrieval aspects can be combined with other email, voice mail, facsimile messaging systems. Cloutier does not suggest that it's notification and retrieval aspects can be combined with other notification methods and networks, such as the type of notification network taught in Goldfinger. As such, there is no motivation to

combine the system of Cloutier with the notification aspects of Goldfinger.

2. The proposed combination of Cloutier in view of Goldfinger does not result in a viably functioning system. In the Office Action mailed April 15, 2004 (hereinafter "Office Action"), a comparison is made in which the message server 12 of the present application is the same as the server 110 of Cloutier, the message notification application 10 of the present application is the same as the messaging system server 120 of Cloutier, the instant messaging service 14 of the present application is the same as the server 20/ network 14 of Goldfinger, and the internet appliance 18 of the present application is the same as the end user terminals 12,16 of Goldfinger. In column 2, lines 34-41, Cloutier teaches that to notify a user that a message has been received at the server 110, the messaging system server 120 generates a unique message code and transmits this code to the end user. However, Cloutier also specifically teaches that transmission of the code is made "using any number of real time delivery device such as a pager, computer connected over a network such as the internet, a PCS phone with SMS messages, etc." This is the exact type of conventional delivery means that the present invention is designed to overcome. On page 2, lines 20-25 of the present specification, such conventional delivery means are referred to as "message notification systems" which include sending numeric messages to a pager, just as Cloutier teaches sending a unique message code to a pager. In contrast, the present invention includes a method of providing message notification for a user through an Instant Messaging Service (Present Specification, page 3, lines 5-6). An Instant Messaging Service is not the same as a message notification system. Cloutier specifically teaches the use of a message notification system, which teaches away from the present invention, and by extension teaches away from any combination using an instant messaging service, such as that described in Goldfinger. Since Cloutier teaches away from the type of instant messaging system taught in Goldfinger, without significant modifications that are beyond the scope of both Cloutier and Goldfinger, the proposed combination of Cloutier and Goldfinger is not a viable combination.

In the Examiner's Answer, it is stated that combining Goldfinger with Cloutier does not change the functionality of either invention because Cloutier suggests that other types of messaging systems may be used in order to notify clients, and Goldfinger provides this messaging system. However, as discussed above in relation to issue 1, Cloutier suggests that it's notification and retrieval aspects can be combined with other email, voice mail, facsimile messaging systems. Cloutier does not teach hint or suggest that it's notification and retrieval aspects can be combined with other notification methods and networks, such as the type of notification network taught in Goldfinger. Therefore, Cloutier would be required to change it's functionality to be used in other

types of notification systems, such as that of Goldfinger.

3. Neither Cloutier, Goldfinger, nor their proposed combination teaches "registering a message notification application to at least one instant messaging service", as claimed. Goldfinger is not cited for teaching this limitation. Within the Office Action, it is stated that Cloutier does teach this limitation. Specifically, column 4, lines 15-25 of Cloutier is cited to support this assertion. The applicants assert that Cloutier does not teach the limitations in particular, the cited passage of Cloutier teaches a messaging system server 120 sending a message notification over the internet 130 to a personal computer 190. In other words, Cloutier teaches sending a notification to an end user access device. Clearly, "sending a notification" and "registering with a service" is not the same. Further, there is no hint, teaching , or suggestion within Cloutier of registering a notification application, such as the messaging system server 120 of Cloutier, to a messaging service, such as an instant messaging service, as claimed.

On page 4, paragraph 3 of the Examiner's Answer, it is stated that Cloutier teaches a system for notification of electronically stored messages that may be implemented using any type of device capable of receiving a message, including a server, and that the messaging system service of Cloutier must be registered with the server in order to communicate with it. Appellant is not entirely clear as specific reference of a "messaging system service" and a "server"as used in the Examiner's Answer. It is assumed that the "messaging system service" refers to the messaging system server 120, and that the "server" refers to the end user access device 190.

Registration is conventionally considered a process by which a user registers with an entity providing a service so that the service can be provided to the user. As such, the appellant contends that the messaging system server 120 of Cloutier, as the provider of a service, has no need to be registered with the end user access device 190, which is the user of the service, since the access device 190 does not provide any service to the messaging system server 120.

Further, with regard to the comments within the Examiner's Answer that the messaging system server 120 of Cloutier must be registered with the serve in order to communicate with it, the appellant contends that there is no basis for this conclusion. In conventional communication systems, there is no requirement for one device to register with another device for the purpose of communicating with each other.

It is specifically claimed that a message notification application is registered to an instant messaging service. There is no hint, teaching, suggestion, or implication within Cloutier to suggest that the messaging system server 120 is registered to any type of service, let alone an instant messaging service.

4. Neither Cloutier, Goldfinger, nor their proposed combination teaches "signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing". Within the Examiner's Answer, it is stated that each "user" in Goldfinger encompasses any entity, and that in the case of the combination of Cloutier and Goldfinger, the "user" would represent the "notification system" of Cloutier. It is also stated that since Goldfinger teaches that a buddy list is provided for each user, then the notification system of Cloutier, as a user of Goldfinger, is also provided a buddy list. However, if the messaging system server 120 of Cloutier functions as a user within Goldfinger as proposed, then according to the teachings of Goldfinger, each user provides a list of sought user (buddy list) (Goldfinger, col. 6, lines 3-5). As such, the messaging system server 120, functioning as a user, would necessarily define it's own buddy list. Another "user", such as user 18 of Goldfinger, can not add themselves to the buddy list of any other user, for example the messaging system server 120 of Cloutier.

In contrast, the present application teaches that the end user accessing at the internet appliance 18 (end user) instructs the message notification application 10 to be added to the buddy list of the message notification application 10 (Present Specification, page 4, lines 18-20). As applied to the claims, the claimed limitations are directed to a user 18 accessing the instant messaging service 14 and then the user 18 signing onto the message notification application 10. The user 18 is then added to the buddy list of the message notification application 10.

V. CONCLUSION

All claims are rejected as being unpatentable over Cloutier in view of Goldfinger. However, for at least the reasons discussed above, there is not proper motivation to combine the notification system of Goldfinger with the messaging system of Cloutier. Within the Examiner's Answer, it is stated that Cloutier suggests that different notification systems can be used, and that this suggestion is the motivation to combine with Goldfinger. In contradiction to this conclusion, the appellant has shown that Cloutier does not suggest that different notification systems can be used, but instead, that different "messaging systems", which are defined in Cloutier to be email, voice mail, and fax systems, can be used. Since Cloutier does not suggest the integration of other notification systems, there is no motivation to combine Cloutier with Goldfinger.

Further, even if there is motivation to combine Cloutier with Goldfinger, which the appellant does not believe to be the case, then the proposed combination does not result in a viably functioning system. Within the Examiner's Answer, it is stated that since Cloutier

suggests that different notification systems can be used, the functionality of Cloutier would not need to be changed in order to combine with the system of Goldfinger. However, as previously discussed, Cloutier does not suggest that different notification systems can be used. As such, Cloutier would be required to change it's functionality to be used in other types of notification systems, such as that of Goldfinger.

Each of the independent claims pending within this appeal include limitations specifying that the message notification application registers itself with an instant messaging service. There is nothing within the teachings of Cloutier or Goldfinger that suggests a message notification application is registered with an instant messaging service.

Each of the independent claims pending within this appeal include limitations specifying that by signing onto the message notification application, the user is associated with an instant messaging service by adding the user to a buddy list of the message notification application. Within the Examiner's Answer, the system of Cloutier is defined as a "user", and as such includes a buddy list. However, the buddy list of the Cloutier "user" is defined by the functions set forth in Goldfinger, which state that a buddy list is predefined by the user. Another user can not add themselves to the Cloutier "user" buddy list. In contrast, the claimed limitations are directed to a user 18 accessing the instant messaging service 14 and then the user 18 signing onto the message notification application 10. The user 18 is then added to the buddy list of the message notification application 10. Therefore, the combination of Cloutier and Goldfinger does not teach the claimed limitation of signing onto the message notification application, the user is associated with an instant messaging service by adding the user to a buddy list of the message notification application.

Accordingly, it is respectfully submitted that Claims 1, 3-20, and 22-27 are allowable over Cloutier in view of Godlfinger. Therefore, a favorable indication is respectfully requested.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: 6-8-05

By: Thomas B. Haverstock
Thomas B. Haverstock
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Attorneys for Applicants

CERTIFICATE OF MAILING (37 CFR§ 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.

Date: 6-8-05 By: Tina D. Ramos